



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,806	10/21/2003	Steven P. Barton	112703-294	6662
29156	7590	10/16/2007	EXAMINER	
BELL, BOYD & LLOYD LLP			SHAPIRO, JEFFERY A	
P.O. Box 1135			ART UNIT	PAPER NUMBER
CHICAGO, IL 60690			3653	
MAIL DATE	DELIVERY MODE			
10/16/2007	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 10/691,806

Filing Date: October 21, 2003

Appellant(s): BARTON ET AL.

OCT 16 2007

GROUP 3600

Robert M. Barrett
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/12/07 appealing from the Office action

mailed 3/27/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/960,915 (decision rendered)

10/713,333 (brief filed)

10/930,968 (brief filed)

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,882,900 B1	Terranova	4-2005
5,992,570	Walter et al	11-1999
5,816,443	Bustos	10-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 62-64 is rejected under 35 U.S.C. 102(e) as being anticipated by Terranova (US 6,882,900 B1).

Regarding Claims 62 and 64, Terranova discloses a point of purchase device (18) in the form of a fuel dispenser that is coupled with a retail purchasing device in the form of quick serve (QSR) menu, as discussed at col. 11, lines 25-35. Regarding obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed, Applicant's Independent Claim 62 states as follows:

"obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed from the point of purchase device."

Note that an owner of Terranova's device (18) can be construed to also be a supplier of the product, i.e., the fuel, that is dispensed from the point of purchase device, i.e., the fuel dispenser. Such an owner, who is also the supplier, and who makes profits from the sale of the fuel, is construed to also be paying himself a fee in the form of profits from the sale of the fuel.

Regarding Claim 63, note that the entire point of purchase device is disclosed as being "integral" with the resale purchasing device since the QSR menu is displayed on the fuel dispenser display. See again, col. 11, lines 25-35.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 44-68, 76 and 102-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bustos (US 5,816,443) in view of Walter et al (US 5,992,570) and further in view of Terranova (US 6,882,900 B1). Bustos discloses the following.

As described in Claims 44, 48-50, 56, 62-65, 67, 76 and 102-111;

- a. allowing a consumer to bring purchasable items to a checkout device (see Bustos, fig. 5a);
- b. scanning the items and accumulating a cost for the scanned items on a display (127), as illustrated in Bustos, fig. 1, and fig. 5a, which

illustrates a clerk scanning items, and figure 5d, which illustrates a monitor (106);

- c. allowing the consumer to select a product (47b) from a dispensing device (20b) located in juxtaposition to the automated checkout (see Bustos, fig. 5a);
- d. automatically dispensing the product from the dispensing device in response to the consumer's selection (see Bustos, fig 5a); and
- e. adding a cost of individual items to the total cost for the scanned items on the display (see Bustos, col. 8, lines 1-49);

Bustos does not expressly disclose, but Walter discloses the following.

As described in Claims 44, 48-50, 56, 62-65, 67, 68, 76 and 102-111;

- f. allowing a consumer to bring purchasable items to an *automated* checkout device (10) (see Walter, col. 2, lines 15-19, for example);
- gi. allowing the consumer to scan the purchasable items and accumulate a cost for the scanned items on a display; (see Walter, Claim 8, for example);
- gii. (68) the point of purchase dispenser is integral with the device that identifies costs-note that Walter discloses scanner (16);

Bustos does not expressly disclose, but Terranova discloses the following.

As described in Claims 44, 47-51, 56, 60-66, 76 and 102-111;

- ei. automatically adding a cost of the dispensed product to the total cost of the scanned items on the display.
- ei. accepting a single payment for all items, including the dispensed product;

See Terranova, col. 8, line 64-col. 9, line 19 and col. 11, lines 25-35.

As described in Claim 45, 48;

- h. use of a touch screen as the display (100);

See Terranova, col. 1, lines 17-20 and col. 7, lines 23-29.

As described in Claims 46 and 104;

- i. allowing the customer to pay for the product using a credit/debit card or cash;

See Terranova, col. 1, lines 47-50.

As described in Claims 49, 50, 52, 53, 56, 57, 65

- j. advertising/prompting a customer to add a dispensable product to their purchase;

See Terranova, col. 8, line 64-col. 9, line 19.

Regarding Claim 53, note that Terranova discloses advertising, but does not specify the time period at which it is presented. However, note that the group of time periods presented in Claim 53 covers all conceivable time periods with respect to the

transaction. Therefore, since Terranova discloses presenting advertisements with respect to the transactions, Terranova is considered to meet Claim 53.

Further regarding Claims 54, 55, 58, 59 and 106, note that it would have been obvious for either an operator to substitute for a customer in operating the machine, taking verbal instruction from said customer, or for the customer himself to perform the task.

Regarding Claim 60, note that Terranova discloses purchasing items at a convenience store, which is considered to include both consumables, such as food, as well as non-consumables, such as lighters and windshield scrapers. Note also that a food item that is not consumed, becomes a non-consumable item.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have replaced the checkout counter of Bustos with the checkout counter of Walker.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

Further, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have incorporated the interface having the features discussed above, as taught by Terranova, in Bustos' checkout counter with dispenser, so that a customer using Bustos' self-checkout would be able to dispense an item, the cost of

which was automatically added to the total of all items purchased at the checkout counter.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

Note also that Bustos provides motivation and teaching for locating an item dispenser at a checkout counter/point of sale (POS).

Walter provides teaching to use a self checkout system in place of a traditional checkout counter with clerk/operator.

Terranova discloses an interface for a customer operated point of sale device which promotes and allows the customer to purchase other items/services at the single POS device.

Based on these teachings, one ordinarily skilled in the art would have found it obvious to incorporate Bustos' dispenser and checkout counter as a self-checkout counter having a display which displays a user interface allowing purchase of the dispensed items during the purchase transaction of other items that have been scanned.

Therefore, the combination of Bustos, Walter and Terranova are considered to read on Applicant's claims as discussed above.

(10) Response to Argument

5. Applicant's arguments filed 7/12/07 have been fully considered but they are not persuasive.

Note also that the recent decision rendered in *KSR International Co. v. Teleflex Inc.*, 550 U.S. __, 82 USPQ2d 1385 (2007) forecloses the argument that a specific teaching, suggestion or motivation is required to support a finding of obviousness. See recent Board decision *Ex Parte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007) (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>).

Regarding Claim 44, Applicant argues that Bustos teaches away from an automated checkout with the product located/stored and dispensed in juxtaposition to the checkout itself. Applicant's newly added claim limitations simply state "storing the product to be dispensed in the dispensing device". Bustos' storage area is connected by pipe to the outlet from which the item is delivered to the customer. This structure is all considered part of the dispenser. Therefore, Applicant's newly added claim language is considered to be met by Bustos. The same is true of Terranova.

Merriam-Webster's Collegiate Dictionary, Tenth Edition, p.941, defines the term "proximate" as meaning "very near or close". The same dictionary defines the term "remote" as "far removed in space, time or relation" at p.989. The same dictionary also defines the term "juxtaposition" as "the act or an instance of placing two or more things side by side" at p. 636.

Again, regarding the terms "remote" and "proximate", these terms are relative terms. In relation to Bustos or Terranova, the items located in the storage areas are construed to be proximate since they are in the same building, in Bustos case, and proximate the fuel pumps in Terranova's case. Additionally, Bustos, figure 5a,

illustrates the dispenser (20b) as being located both "proximate" and "in juxtaposition to", i.e., placed side-by-side with the checkout counter. Either way, even if it was construed that they were not proximate, it would have been obvious to do so since the size of the conduit through which the items travel is a matter of design choice based on situational requirements. Terranova still teaches the concept of adding the cost of the dispensed product to the total cost of the customer's bill.

Regarding Claims 48, 102, and 106-111, Terranova discloses use of a touch screen. Applicant appears to misread the passage at col. 7, lines 23-29. A key pad is well-known to be a set of keys in the form of a keyboard. A touch interface, however, can only be integrated with the display to form a touch interface in the implementation of a touch screen. This is also considered the more likely interpretation since the passage previously mentions the keyboard/keypad as adjacent to the display. Additionally, Terranova at col. 1, lines 17-20 refers to "user interfaces with large displays and touch-pads or screens" as being typical in fuel dispensers, which further buttresses the interpretation of Terranova's touch screen interface to be a touch screen as called for in Applicant's claims.

Regarding Claim 49, Walter, as admitted by Applicants, does disclose a customer prompt. Since this is in part what the teaching of Walter is used for, the fact that it prompts for any product can be construed to include products located anywhere in the store, either at the point of purchase or far away therefrom.

Regarding Claim 50, Terranova, at col. 8, line 64-col. 9, line 8, discloses a prompt for items able to be dispensed at the fuel dispenser. The media presentations

and displays described by Terranova are considered to meet the limitations of a means to prompt the consumer that "the product is available at the point of purchase."

Regarding Claims 56, 65, 76 and 106, Bustos discloses various items stored and dispensed. Note in figure 4a, b, a soda bottle is dispensed, while in figure 4c, a hotdog is being dispensed. Even if it were considered not disclosed, at the very least, it would be considered obvious to prompt the customer it buy any number of items able be dispensed by Bustos' dispenser because the intent of Bustos' dispenser is to sell items, and this would have been an obvious way of bringing such items to the attention of the customer for purchase. This combined with Terranova's teaching at col.9, lines 4-8 to "provide a video menu at the display to facilitate selection of various services, goods and food available for purchase." Again, note that Applicant's Claims 56, 65, 76 and 106 can be construed to read on Bustos and Terranova since both Bustos' and Terranova's dispensers store items, and dispense them at the point of purchase. The nozzle in Terranova's device can be construed to dispense items at the point of purchase as is Bustos' product exit (20b) illustrated in figure 5a.

Further regarding Claims 106 and 109, Terranova teaches advertising/prompting a customer to add a dispensable product to their purchase at col. 8, line 64-col. 9, line 19. Note col. 8, lines 64-67 which specifically mentions audio/video electronics (86, 156) that provides "advertising, merchandising and multimedia presentations to the customer". Such advertising and multimedia presentations are construed as being of a dynamic nature, as the definitions of these terms so suggest, especially when used in proximity to each other.

Regarding Claim 110, note again that it would have been obvious in light of both Bustos and Terranova to dispense any conceivable product that one ordinarily skilled in the art would consider customers would like to purchase in their dispensers so as to provide profit. Gum or candy is just such an item. Also, gum or candy is well-known to be bought and sold in vending machines and at gas stations/convenience stores such as Bustos' or Terranova's.

Regarding Claims 62 and 64, again note that Terranova discloses a point of purchase device (18) in the form of a fuel dispenser that is coupled with a retail purchasing device in the form of quick serve (QSR) menu, as discussed at col. 11, lines 25-35. Regarding obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed, Applicant's Independent Claim 62 states as follows:

"obtaining a fee paid from a supplier of the product in exchange for allowing the product to be dispensed from the point of purchase device."

Nowhere in Independent Claim 62, or Claims 63 and 64, is there a limitation mentioned that requires the supplier to be a "third party". Note that an owner of Terranova's device (18) can be construed to also be a supplier of the product, i.e., the fuel, that is dispensed from the point of purchase device, i.e., the fuel dispenser. Such an owner, who is also the supplier, and who makes profits from the sale of the fuel, is construed to also be paying himself a fee in the form of profits from the sale of the fuel.

Regarding Claim 63, note that the entire point of purchase device is disclosed as being "integral" with the resale purchasing device since the QSR menu is displayed on the fuel dispenser display. See again, col. 11, lines 25-35.

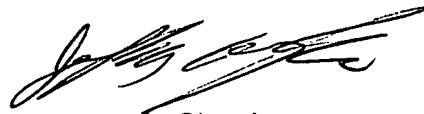
Therefore, Claims 44-68, 76 and 102-111 are rejected.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



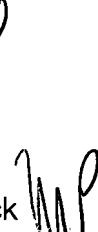
Jeffrey A. Shapiro,

Examiner, AU 3653

Conferees:

Patrick H. Mackey

Meredith C. Petravick



JAS
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 3600

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN P. BARTON
and PAUL CHIBE

Appeal No. 2005-2771
Application No. 09/960,915

HEARD January 25, 2006

MAILED

FEB 15 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before HAIRSTON, RUGGIERO, and NAPPI, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 15, 25, 74, 85-89, 94-97, and 111. Claims 1-14, 16-24, 26-73, 75-84, 90-93, and 102-110 have been canceled, and claims 98-101 have been withdrawn from consideration as being directed to a non-elected invention. An amendment filed October 31, 2003 after final rejection was approved for entry by the Examiner.

Appeal No. 2005-2771
Application No. 09/960,915

The disclosed invention relates to a system which automates the purchase of point of purchase products. In a particular embodiment, which operates with a self-scanning checkout terminal, products are immediately dispensed to a consumer at the point of purchase. The cost of the dispensed products is added to the cost of the items collected by the consumer and brought to the point of purchase checkout terminal, thereby permitting the consumer to make one payment for both the dispensed products and the collected retail items.

Claim 15 is illustrative of the invention and reads as follows:

15. A device allowing a consumer to purchase product without the need for a cashier comprising:
a body having an interior;
a controller coupled to the body;
a scanning device that communicates with and is coupled to the controller, the scanning device allowing a consumer to scan purchasable items that the consumer brings to the device and accumulate a cost for the items;
a product maintained within the interior of the body;
the body including a dispenser that dispenses the product from the body upon a request for product by the consumer, wherein a cost for the product is added to the cost for the items; and
a display that prompts the consumer to purchase the product.

The Examiner relies upon the following prior art:

Bustos	5,816,443	Oct. 06, 1998
Walter et al. (Walter)	5,992,570	Nov. 30, 1999

Appeal No. 2005-2771
Application No. 09/960,915

Claims 15, 25, 74, 85-89, 94-97, and 111, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Bustos in view of Walter.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs, the final Office action, and Supplemental Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection, and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Supplemental Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in appealed claims 15, 25, 74, 85-89, 94-97, and 111. Accordingly, we affirm.

As a general proposition in an appeal involving a rejection under 35 U.S.C. § 103, an Examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to Appellants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed waived [see 37 CFR § 41.37(c)(1)(vii)].

With respect to independent claim 15, Appellants' arguments in response to the Examiner's 35 U.S.C. § 103(a) rejection assert a failure to establish a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art references. Appellants' arguments (Brief, page

Appeal No. 2005-2771
Application No. 09/960,915

11), in asserting distinction of appealed claim 15 over Bustos, direct attention to portions of the disclosure of Bustos in which it is stated that a primary object of the invention of Bustos is to store items to be dispensed at a location remote from a checkout terminal.

After careful review of the applied prior art references in light of the arguments of record, however, we are in general agreement with the Examiner's position as stated in the Supplemental Answer. Initially, we make the observation that, in contrast to Appellants' assertion, the language of claim 15 sets forth no spatial relationship between the product storage unit and the checkout terminal. We also agree with the Examiner's interpretation (final Office action, pages 2-4) of Bustos which concludes that, as required by claim 15, Bustos discloses a body (building 15 or vault 25), which stores products to be dispensed, coupled to a controller 55 and a scanning checkout terminal 127, and further including a dispenser 26 to dispense items requested by a consumer.

With respect to the claimed feature of a display with a prompt that prompts a consumer to purchase a product, we agree with the Examiner (Supplemental Answer, pages 4 and 5) that

Appeal No. 2005-2771
Application No. 09/960,915

Appellants have not adequately traversed the Examiner's taking of Official Notice with respect to this feature. Our review of the record before us reveals that Appellants' traversal, in contrast to the requirement that supposed errors by the Examiner must be specifically pointed out, merely asserts that the applied Bustos and Walter references do not disclose such "prompting" feature. It is well settled that to adequately traverse a finding of Official Notice, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See In re Chevenard, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943).

We would also point out that, aside from our difficulties with the adequacy of Appellants' traversal of the Examiner's taking of Official Notice, our independent review of the disclosure of Bustos reveals that Bustos does in fact include a disclosure of a prompting feature. For example, at lines 54-66 of column 11, Bustos discloses a displayed prompt to a customer asking if the customer would like to purchase one of the stored products in storage vault 25. We also find no error in the Examiner's assertion (Supplemental Answer, page 4) that the menu list of

Appeal No. 2005-2771
Application No. 09/960,915

items displayed to a customer as illustrated in Figure 5D of Bustos, for example, would be considered a "prompt" to purchase any of the items, at least in the manner broadly claimed by Appellants.

Lastly, with respect to appealed claim 15, we find no error in the Examiner's establishment (final Office action, page 4) of proper motivation for the proposed combination of the self-service checkout teachings of Walter with the system of Bustos. To whatever extent Appellants' argument (Brief, page 13) that the remote storage aspect of Bustos "teaches away" from the claimed invention has any merit, there is no spatial relationship between the stored and dispensed products and the checkout set forth in appealed claim 15, as discussed supra. Further, contrary to Appellants' contention (id.), there is no need to provide motivation to modify Bustos to include a prompt since Bustos already includes a prompt.

In view of the above discussion, since it is our opinion that the Examiner's prima facie case of obviousness has not been overcome by any convincing argument from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of independent claim 15 is sustained.

Turning to a consideration of the Examiner's obviousness rejection of independent claims 25 and 74 based on the combination of Bustos and Walter, we sustain this rejection as well. We note that, in contrast to independent claim 15 previously discussed, claims 25 and 74 set forth a spatial relationship between the product storage device and the check out terminal by reciting, in claim 25, the product housing body being "located at a point of purchase" and, in claim 74, the storing and dispensing device being located "at least proximate to the cost identifying device."

Although appealed claims 25 and 74 attempt to define a spatial relationship between the storage and dispensing device and a point-of-purchase device, we agree with the Examiner that the retail counter portion of the disclosure of Bustos (element 24, column 7, lines 21-23 and column 8, lines 21-27) satisfies the claimed relationship. In our view, the housing structure 15 in Bustos constitutes a point-of-purchase location which includes the storage vault 25, dispenser 26, and retail counter checkout terminal 24 with a display screen. Thus, we find no error in the Examiner's interpretation that the storage vault 25 in Bustos, which houses the products to be dispensed, is located "at a

point-of-purchase" (appealed claim 25), or that the storing and dispensing device (elements 25 and 26 in Bustos) are "located at least proximate to the cost identifying device" (claim 74).

We do not disagree with Appellants (Brief, page 10; Supplemental Reply Brief, page 5) that Bustos discloses that an object of his invention is to deliver products to a customer at "remote" locations where, because of the lack of climate control, it is inconvenient and impractical to store such products. The operation of the invention of Bustos in such an environment is described and illustrated in Figure 1 of Bustos where products stored inside the environmentally controlled building 25 are dispensed, and paid for by the customer, at the outdoor gasoline pump location. It is apparent to us, however, that while Bustos is indeed concerned with dispensing consumer products to locations which are remote from an environmentally-controlled storage location, it is quite clear that Bustos also provides a disclosure of the dispensing of stored products within such locations such as the retail counter illustrated in the left hand portion of Figure 1 and discussed at column 7, lines 21-23 and column 8, lines 21-27. As discussed supra, we find that the claim language requiring that products be stored, or stored and

Appeal No. 2005-2771
Application No. 09/960,915

dispensed, "at a point of purchase" or "at least proximate" to a checkout terminal does not distinguish over the retail counter disclosure of Bustos where the "point-of-purchase" is within a structure that houses the storage vault, dispenser, and checkout terminal. With respect to the requirement of claim 74 that the prompting means is "part of" the cost identifying device and dispenser, it is our view that the retail checkout counter housed inside the building structure 15 in Bustos includes the prompting display as well as the dispenser located at the surface of the checkout counter as illustrated in Figure 1.

We further find to be unpersuasive Appellants' argument (Supplemental Reply Brief, page 4) calling attention to the fact claim 74 is written in means-plus-function language and, accordingly, the language of claim 74 must be interpreted in accordance with 35 U.S.C. § 112, paragraph six. Appellants, however, have pointed to no corresponding structure within the specification to which the claimed "means for prompting" refers nor have Appellants indicated what is to be construed as "equivalents thereof" or why the structure disclosed by Bustos, as we discussed in the paragraph above, for example, may not be considered "equivalent."

We also sustain the Examiner's 35 U.S.C. § 103(a) rejection of claims 85-89, which include limitations directed to the feature of receiving advertisement information from a remote location, based on the combination of Bustos and Walter. We find no error in the Examiner's position (Supplemental Answer, pages 7-10) which asserts that the list of displayed menu items on the display screen 106 in the Figure 5D embodiment of Bustos corresponds to the claimed "advertisement information." We further agree with the Examiner that the ordinarily skilled artisan would have recognized and appreciated that this advertisement information would have been downloaded from remote locations such as the hotel kitchen 123 or bar area 122 in order for the consumer to know which items, and their pricing, are available at a particular time.

We also recognize that the language of claim 85 represents another attempt by Appellants to define spatial relationships among the elements of the system by reciting that the product dispenser is located "at least in juxtaposition to the item input device." Again, we agree with the Examiner that such language does not distinguish over, for example, the embodiment illustrated in Figure 5D of Bustos where the dispensing device

Appeal No. 2005-2771
Application No. 09/960,915

105 is placed "in juxtaposition," i.e., in a side-by-side relationship with the item input device, i.e., the television set 107 which can be operated by its associated remote 108.

We next consider the Examiner's obviousness rejection of claims 94-97 which set forth the use of "smart prompts" based on data collected with respect to a particular consumer. We also sustain this rejection and make reference to our earlier discussion with respect to our finding that Appellants have not adequately traversed the Examiner's taking of Official Notice of the well known aspects of prompts and smart prompts in the field of marketing.

We also expand our comments by making the observation that a finding of fact relying on Official Notice may be easily traversed by either denying the fact or averring that applicant is without knowledge of its truth or falsity, which has the effect of a denial. "Traverse" is defined as "[a] formal denial of a factual allegation in the opposing party's pleading," Black's Law Dictionary (7th ed. 1999). That is, a traverse is similar to answering the factual allegations in a complaint in a civil action. A proper traverse indicates that a fact is genuinely contested and a reference must be found. Mere argument

Appeal No. 2005-2771
Application No. 09/960,915

that the Official Notice is not supported by a reference is not a traverse because such assertion does not indicate whether the fact is actually denied or whether applicant is just forcing the Office to spend time to find a reference.

We also find no error in the Examiner's establishment of motivation for the proposed modification of the system of Bustos as modified by Walter to include consumer-specific smart prompts for the reasons articulated by the Examiner (final Office action, page 4; Supplemental Examiner's Answer, pages 5, 6, 8, and 11). In our view, since, Appellants' argument to the contrary notwithstanding, Bustos already has a disclosure of using prompts for consumer purchasing, the ordinarily skilled artisan would have recognized and appreciated that the addition of consumer-specific smart prompts would have been an obvious enhancement to the system of Bustos as modified by Walter.

Further, with respect to separately argued dependent claim 111, we agree with the Examiner that several of the embodiments described by Bustos can be reasonably interpreted as disclosing a dispensing device "positioned integral with item input device." For example, in our view, the dispenser 26 is positioned integral with item input device 127 as part of the retail counter in

Appeal No. 2005-2771
Application No. 09/960,915

Figure 1 of Bustos. Similarly, Figures 5A and 5B of Bustos illustrate arrangements in which the dispenser is integral with the item input device in the form of a keypad for consumer entry. Accordingly, the Examiner's 35 U.S.C. § 103(a) rejection of dependent claim 111 based on the combination of Bustos and Walker is sustained.

Lastly, we find to be unpersuasive Appellants' argument (Brief, page 13; Supplemental Reply Brief, page 6) that Bustos "teaches away" from the claimed invention. In making this argument, Appellants direct attention to the embodiment illustrated in Figure 5A of Bustos which, in contrast to the claimed self-checkout feature, illustrates an attended checkout counter at the point of purchase. While we agree with Appellants that the Figure 5A embodiment of Bustos illustrates an attended checkout terminal, the problems of which Appellants' invention is attempting to solve, it is quite apparent that Bustos also contemplates unattended self checkout point-of-purchase terminals. For example, at column 4, lines 18-21, Bustos states that a further objective of his invention is to provide "completely unattended consumer sales of products" With the above discussion in mind, we remain of the opinion that, for all

Appeal No. 2005-2771
Application No. 09/960,915

of the reasons articulated by the Examiner, the ordinarily skilled artisan would have been motivated and found it obvious to modify Bustos to include self checkout terminals, such as taught by Walter, wherever attended terminals may be located in Bustos such as the attended retail counter inside the housing structure 15 of Figure 1 of Bustos.

In summary, we have sustained the Examiner's 35 U.S.C. § 103(a) rejection of all of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 15, 25, 74, 85-89, 94-97, and 111 is affirmed.

Appeal No. 2005-2771
Application No. 09/960,915

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004)).

AFFIRMED

JFR/kis

Appeal No. 2005-2771
Application No. 09/960,915

BELL, BOYD & LLOYD, L.L.C.
P. O. BOX 1135
CHICAGO, IL 60690-1135